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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,005	10/25/2000	Albert I. Everaerts	56117 USA 1A	4526

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3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

FISCHER, JUSTIN R

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/697,005	Applicant(s) EVARAERTS ET AL.	
	Examiner Justin R Fischer	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-37, 39-41, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 19-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-37, 39-41, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. In response to applicant's traversal of the restriction requirement, applicant is pointed to MPEP 818.02, which states that "the claims as originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination which has been filed for the application." In this instance, the originally presented claims included a genus in which a plasticizing agent was broadly claimed and a species in which a solid plasticizing agent was claimed. This is significantly different from the situation set out in MPEP 818.02 (b), which states that "where **only generic claims** are first presented...he or she must at that time indicate an election of a single species". Thus, since a genus and species (solid) were originally presented, these claims represent the originally presented claims and as such, the claims directed to a liquid plasticizing agent are directed to a non-elected invention by original presentation.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 34-37, 39-41, 43, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukumoto (JP 62-263270). Fukumoto is applied in the same manner as set forth in the Non-Final Rejection mailed on March 15, 2004.

Fukumoto is directed to a method of applying a pressure sensitive adhesive to a substrate comprising the steps of providing a substrate (e.g. polyurethane), applying a mixture comprising a latent, over-tackified adhesive and a solid plasticizing agent to said substrate, and applying heat to melt said solid plasticizing agent and activate said adhesive (Derwent Abstract, JPO Abstract, and oral translation from USPTO translator). The adhesive (resin substance) of Fukumoto is seen to constitute a "latent, over-tackified adhesive" since the adhesive properties are not due to a relatively large amount of tackifier but rather acquire adhesivity upon activation by the heating and melting the plasticizing agent (this is the definition given in the original disclosure- Page 2, Line 33+). Furthermore, after applying heat and activating the adhesive, Fukumoto describes placing a second substrate, for example a plastic or metal sheet, over the activated adhesive (oral translation from USPTO translator). Lastly, in regards to the adhesive or resin component, Fukumoto suggests the use of methacrylic polymers and olefins, such as ethylene and propylene (oral translation from USPTO translator- Page 2, upper paragraphs of Columns 1 and 2).

Regarding claims 35 and 36, as noted in the 112, 2nd Paragraph rejections above, these limitations do not appear to further limit the embodiment in which the respective components are simultaneously added. Furthermore, the language "selective regions" does not exclude the placement of the plasticizing agent over the entire extent of the adhesive.

With respect to claims 37 and 41, the solid plasticizers of Fukumoto, for example dicyclohexyl phthalate, are seen to constitute non-reactive additives.

Regarding claims 43 and 44, the article of Fukumoto is seen to constitute an adhesive article in that it is formed in an analogous manner to the claimed invention (i.e. a base substrate is coated with a mixture of adhesive and plasticizing agent and subsequently heated to impart adhesivity). Also, the article at this point is seen to constitute a "tape" in that said mixture is coated onto a sheet, there being no specific structure or disclosure that defines a "tape" as being different or distinct from the article of Fukumoto.

Response to Arguments

4. Applicant's arguments filed August 16, 2004 have been fully considered but they are not persuasive. Regarding the restriction requirement, see Paragraph 1 above. With respect to the claim rejections, applicant has amended the claim to require the adhesive substance be either a meth(acrylic) polymer, poly(alpha-olefin), or silicone. While the abstract of Fukumoto fails to teach these materials, Columns 1 and 2 of the reference detail the use of a wide variety of adhesive/resin substances, including methacrylic polymers and olefins, such as ethylene and propylene.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Justin Fischer



BLAINE COPENHEAVER
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 1700

September 17, 2004